

REMARKS

This Amendment is filed in response to the Office Action dated March 11, 2009. The Applicant respectfully requests reconsideration. All objections and rejections are respectfully traversed.

Claims 1-30 are pending in the application.

No claims have been added or amended.

Claim Rejections - 35 U.S.C. §103

At paragraphs 1-2 of the Office Action, claims 1-30 were rejected under 35 U.S.C. §103(a) over Soon et al., U.S. Publication No. 2004/0001443 (hereinafter “Soon”), in view of Clancy et al., U.S. Patent No. 7,039,703 (hereinafter “Clancy”).

Clancy is Disqualified as Prior Art by Operation of 35 U.S.C. §103(c)

Clancy and the subject matter of the present application were both owned by Cisco Technology, Inc. at the time that the present invention was made.

The statute 35 U.S.C. 103(c) states (emphasis added):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability** under this section where the subject matter and claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation to the same person.

The subject matter of the present Application was developed by inventors having an obligation to assign their rights to Cisco Technology, Inc. The present application was assigned to Cisco Technology, Inc. by an assignment recorded at Reel/Frame 014955/0198 on Jan. 30, 2004.

Clancy was previously assigned to Cisco Technology, Inc. by an assignment recorded at Reel/Frame 012545/0004 on Jan. 24, 2002.

35 U.S.C. §103(c) is satisfied since Clancy does not qualify as §102(a), (b), (c) or (d) prior art.

35 U.S.C. §102(a) states a person is entitled to a patent unless “the invention... was patented or described in a printed publication... before the invention thereof by the applicant.” Clancy does not qualify as prior art under §102(a) because the invention was invented by the Applicant before Clancy published. The Applicant filed this Application on Jan. 20, 2004 and Clancy did not publish until May 2, 2006, its issue date.

35 U.S.C. §102(b) states a person is entitled to a patent unless “the invention was patented or described in a printed publication ... more than one year prior to the date of the application for patent in the United States.” Clancy does not qualify as prior art under §102(b) because this application was filed before Clancy published.

35 U.S.C. §102(c) states a person is entitled to a patent unless “he has abandoned the invention.” The Applicant has not abandoned the present invention.

35 U.S.C. §102(d) states a person is entitled to a patent unless “the invention was first patented or caused to be patented ... in a foreign country prior to the date the application for patent in this country on an application for patent ... filed more than twelve months before the filing of the application in the United States.” The present invention was not patented in a foreign country before filing in the United States.

Accordingly, the Applicant respectfully urges that Clancy may only potentially qualify as prior art only under 35 U.S.C. §102(e), §102(f), or §102(g). Therefore, all the requirements of 35 U.S.C §103(c) are satisfied, and Clancy is legally precluded from serving as a reference under 35 U.S.C. §103(a) by operation of 35 U.S.C §103(c).

Soon Alone Does Not Disclose What is Claimed

The Applicant’s amended claim 1, representative in part of the other rejected claims, sets forth (emphasis added):

1. A method for modifying and testing a network protocol stack that includes a plurality of protocols, the method comprising:

executing a test of said network protocol stack using a processing system, the test modeling each protocol of said plurality of protocols of said protocol stack as separate objects, the test simulating communication between a plurality of devices using said network protocol stack;

receiving a command comprising code *to modify one of said plurality of protocols in said protocol stack*; and

performing said modification on said one of said plurality of protocols in said protocol stack while the test is executing, by changing said separate object corresponding to said one of said plurality of protocols in said protocol stack.

As discussed in the previous amendment, Soon is silent concerning the Applicant's claimed "*receiving a command ... modify one of said plurality of protocols in said protocol stack*" and "*performing said modification on said one of said plurality of protocols in said protocol stack while the test is executing, by changing said separate object corresponding to said one of said plurality of protocols in said protocol stack.*"

Indeed, the Examiner appears to agree that Soon does not teach these elements of the claims, stating at pages 2-3 of the Office Action that (emphasis in original):

However, Soon does not explicitly disclose:

- receiving a command comprising code to modify one of said plurality of protocols in said protocol stack; and
- performing said modification on said one of said plurality of protocols in said protocol stack, while the test is executing, by changing said separate object corresponding to said one of said plurality of protocols in said protocol stack.

As Clancy has been disqualified as prior art, and there is agreement that Soon does not teach several elements of the Applicant's claims, the Applicant respectfully urges that the claims are not obvious under 35 U.S.C. §103(a) and respectfully requests issue of a Notice of Allowance.

In the event that the Examiner deems personal contact desirable in disposition of this case, the Examiner is encouraged to call the undersigned attorney at (617) 951-2500.

In summary, all the independent claims are believed to be in condition for allowance and therefore all dependent claims that depend there from are believed to be in condition for allowance. The Applicant respectfully solicits favorable action.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

/James A. Blanchette/
James A. Blanchette
Reg. No. 51,477
CESARI AND MCKENNA, LLP
88 Black Falcon Avenue
Boston, MA 02210-2414
(617) 951-2500